



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,814	02/20/2004	Steven Markin		7058

7590 09/24/2008
Stephen E. Feldman, P.C.
12 East 41st Street
New York, NY 10017

EXAMINER

AHLUWALIA, NAVNEET K

ART UNIT	PAPER NUMBER
----------	--------------

2166

MAIL DATE	DELIVERY MODE
-----------	---------------

09/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/783,814	Applicant(s) MARKIN, STEVEN	
	Examiner NAVNEET K. AHLUWALIA	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the Amendment filed 06/06/2008.

Response to Arguments

2. Claims 24 – 46 are pending in this Office Action, after a further search and a thorough examination of the present application, the claims 24 – 46 remain rejected. The claim objections to claims 24 – 46 are withdrawn in view of the amendment.

3. Applicant's arguments filed with respect to claims have been fully considered but they are not persuasive. The rejection is maintained and citations are proved in the rejection below.

Applicant argues that Williams does not disclose the use of the regulations data as located. Furthermore, Applicant tries to summarize the reference used and then states that the regulation data is not taught.

Examiner respectfully disagrees and states that Williams teaches the use of the regulations data and the regulatory policies in paragraphs 52, 54, 57 and 61 – 62, of Williams, where it is disclosed how these policies are integrated with security and vulnerability concerns. Furthermore, the applicant mischaracterizes the teaching of Williams in an effort to summarize the teachings. Regardless, the instant application claims the provision of regulation data and determination of regulation data being applied to vulnerabilities and these features are taught by Williams in paragraphs 54 and 57 where the regulatory and regulation policies are provided and with the

Art Unit: 2166

combination of the audit repository and the compliance server the compliance server by analyzing the data determine the regulation and the vulnerability.

Since the applicant's arguments after having been considered have not overcome the rejection, therefore the rejection is maintained.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 24 – 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al. ('Williams' herein after) (US 2005/0015623 A1).

With respect to claim 24,

Williams discloses a method for effectively and efficiently identifying violations of privacy and security and guidelines in an information system while documenting and accommodating the live process of compliance and security testing (paragraphs 91, 148, 151 and 153), comprising the steps of :

- a. providing vulnerability data having universal definitions applicable to different computing systems (paragraphs 54 and 70, Williams);

Art Unit: 2166

- b. providing regulation data relating to and taken from a particular set of regulations (paragraphs 73 and 166, Williams);
- c. providing priority data relating to a list of vulnerabilities prioritized in a specific order (paragraph 212, Williams);
- d. providing keywords that are common to the vulnerability, regulation and priority data (paragraphs 0139 and 0141, Williams);
- e. searching for the keywords in the vulnerability, regulation and priority data (paragraphs 0139 and 0141, Williams);
- f. creating relational data based upon the searching step, the relational data establishes a specific relationship between the vulnerability, regulation and priority data (paragraphs 0053 and 0136 – 0137, Williams);
- g. determining a computer configuration for a target to be tested (paragraphs 56 and 103, Williams);
- h. customizing a screening process for the target using the computer configuration found in the determining step (paragraphs 57 and 99, Williams);
- i. testing for vulnerability violations in the target based upon the customized screening process (paragraphs 92 – 93 and 135, Williams);
- j. determining, according to the vulnerability violations, which regulation data applies to which vulnerability data and the priority of the vulnerability violations by a relational database for providing a mapping between the vulnerabilities and the regulations (Figures 2 and 3, Williams); and

Art Unit: 2166

- k. creating a prioritized report corresponding to the vulnerability violations and the regulations that apply to the vulnerability violations (Figures 2 and 3, Williams).

With respect to claim 25,

Williams discloses the method of claim 24 wherein the set of regulations are defined by Health Insurance Portability and Accountability Act (paragraph 0066, Williams).

With respect to claim 26,

Williams discloses the method of claim 24 wherein the set of regulations are defined by Graham Leach Bailey Act (paragraph 0066, Williams).

With respect to claim 27,

Williams discloses the method of claim 24 wherein the vulnerability violations are stored in a memory (paragraph 147, Williams).

With respect to claim 28,

Williams discloses the method of claim 24 wherein the testing step further comprises scanning a target to provide a system scan (paragraphs 0109, Williams).

With respect to claim 29,

Williams discloses the method of claim 28 further comprising the step of providing a test set as a function of the system scan (paragraphs 0111 – 0112, Williams).

With respect to claim 30,

Williams discloses the method of claim 24 the prioritized report further includes an IP address of the target (paragraph 0170, Williams).

With respect to claim 31,

Williams discloses the method of claim 24 wherein the vulnerabilities data is defined by Common Vulnerabilities and Exposures (paragraph 0168, Williams).

With respect to claim 32,

Williams discloses a information system for effectively and efficiently identifying violations of privacy and security and guidelines while documenting and accommodating the live process of compliance and security testing (paragraphs 91, 148, 151 and 153), comprising:

- a. a vulnerability database having universal definitions applicable to different computing systems (paragraphs 54 and 70, Williams);
- b. a regulation database relating to and taken from a particular set of regulations (paragraphs 73 and 166, Williams);

Art Unit: 2166

- c. a priority database relating to a list of vulnerabilities prioritized in a specific order (paragraph 212, Williams);
- d. means for providing keywords that are common to the vulnerability, regulation and priority data (paragraphs 0139 and 0141, Williams);
- e. searching means for searching for the keywords in the vulnerability, regulation and priority data (paragraphs 0139 and 0141, Williams);
- f. a memory for storing relational data that was created by the searching means, the relational data establishes a specific relationship between the vulnerability, regulation and priority databases (paragraphs 0053 and 0136 – 0137, Williams);
- g. first determining means for determining a computer configuration for a target to be tested (paragraphs 56 and 103, Williams);
- h. customizing means for customizing a screening process for the target using the computer configuration found in the first determining means (paragraphs 57 and 99, Williams);
- i. testing means for testing for vulnerability violations in the target based upon the customized screening process (paragraphs 92 – 93 and 135, Williams);
- j. second determining means for determining, according to the vulnerability violations, which regulation data applies to which vulnerability data and the priority of the vulnerability violations by a relational database for providing a mapping between the vulnerabilities and the regulations (Figures 2 and 3, Williams); and

Art Unit: 2166

- k. a prioritized report corresponding to the vulnerability violations and the regulations that apply to the vulnerability violations (Figures 2 and 3, Williams).

With respect to claim 33,

Williams discloses the system of claim 32 wherein the set of regulations are defined by Health Insurance Portability and Accountability Act (paragraph 0066, Williams).

With respect to claim 34,

Williams discloses the system of claim 32 wherein the set of regulations are defined by Graham Leach Bailey Act (paragraph 0066, Williams).

With respect to claim 35,

Williams discloses the system of claim 32 wherein the vulnerability violations are stored in a memory (paragraph 147, Williams).

With respect to claim 36,

Williams discloses the system of claim 32 wherein the testing means further comprises scanning a target to provide a system scan (paragraphs 0109, Williams).

With respect to claim 37,

Williams discloses the system of claim 36 further comprising a test set as a function of the system scan (paragraphs 0111 – 0112, Williams).

With respect to claim 38,

Williams discloses the system of claim 32 wherein the prioritized report further includes an IP address of the target (paragraph 0170, Williams).

With respect to claim 39,

Williams discloses the system of claim 24 wherein the vulnerabilities data is defined by Common Vulnerabilities and Exposures (paragraph 0168, Williams).

With respect to claim 40,

Williams discloses the computer-executable process steps, stored on a computer-readable medium and executable by a processor to perform the steps of:

- a. document and accommodate a live process of compliance and security testing (paragraphs 91, 148, 151 and 153)
- b. provide vulnerability data having universal definitions applicable to different computing systems (paragraphs 54 and 70, Williams);
- c. provide regulation data relating to and taken from a particular set of regulations (paragraphs 73 and 166, Williams);
- d. provide priority data relating to a list of vulnerabilities prioritized in a specific order (paragraph 212, Williams);

Art Unit: 2166

- e. provide keywords that are common to the vulnerability, regulation and priority data (paragraphs 0139 and 0141, Williams);
- f. search for the keywords in the vulnerability, regulation and priority data (paragraphs 0139 and 0141, Williams);
- g. create relational data based upon the search step, the relational data establishes a specific relationship between the vulnerability, regulation and priority data (paragraphs 0053 and 0136 – 0137, Williams);
- h. determine a computer configuration for a target to be tested (paragraphs 56 and 103, Williams);
- i. customize a screening process for the target using the computer configuration found in the determine step (paragraphs 57 and 99, Williams);
- j. test for vulnerability violations in the target based upon the customized screening process (paragraphs 92 – 93 and 135, Williams);
- k. determine, according to the vulnerability violations, which regulation data applies to which vulnerability data and the priority of the vulnerability violations by a relational database for providing a mapping between the vulnerabilities and the regulations (Figures 2 and 3, Williams); and
- l. create a prioritized report corresponding to the vulnerability violations and the regulations that apply to the vulnerability violations (Figures 2 and 3, Williams).

With respect to claim 41,

Art Unit: 2166

Williams discloses the steps of claim 40 wherein the set of regulations are defined by Health Insurance Portability and Accountability Act (paragraph 0066, Williams).

With respect to claim 42,

Williams discloses the steps of claim 40 wherein the set of regulations are defined by Graham Leach Bailey Act (paragraph 0066, Williams).

With respect to claim 43,

Williams discloses the steps of claim 40 wherein the test step further comprises scanning a target to provide a system scan (paragraphs 0109, Williams).

With respect to claim 44,

Williams discloses the steps of claim 43 further comprising the step of providing a test set as a function of the system scan (paragraphs 0111 – 0112, Williams).

With respect to claim 45,

Williams discloses the steps of claim 40 wherein the prioritized report further includes an IP address of the target (paragraph 0170, Williams).

With respect to claim 46,

Art Unit: 2166

Williams discloses the steps of claim 40 wherein the vulnerabilities data is defined by Common Vulnerabilities and Exposures (paragraph 0168, Williams).

Conclusion

6. THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Navneet K. Ahluwalia whose telephone number is 571-272-5636.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam T. Hosain can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Navneet K. Ahluwalia/
Examiner, Art Unit 2166

Dated: 09/19/2008

/Hosain T Alam/
Supervisory Patent Examiner, Art Unit 2166